Appendix C—

Opinion of the Superior Court of New Jersey, Appellate Division.

VII.

Several other matters raised by plaintiff call for comment.

Plaintiff complains of the exclusion by the trial court of a communication to her from a patent examiner in relation to a pending application by plaintiff for a patent on the subject matter of the invention here involved. Disregarding questions as to the hearsay nature of the document, this was not a final action or determination of the agency itself, and, in our judgment, any inferences as to patentability of either the process or the new use based thereon would be most speculative, to say the least. There was no prejudicial error in its exclusion.

Plaintiff also charges error in the denial of her offer of the testimony of an expert witness who testified on her behalf in the previous litigation between the parties as to the patentability of the process. The witness was said to be out of the jurisdiction. It suffices to dismiss this objection that the subject matter of the respective actions is not substantially identical. *Welch* v. *County of Essex,* 6 N. J. Super. 422 (Cty. Ct. 1949), affirmed, 6 N. J. Super. 184 (App. Div. 1950). In fact, it is substantially different.

It is argued that there was error in not instructing the jury to take into consideration certain facets of the evidence in relation to the good faith of the defendants, *e.g.,* Kell's failure to consult with plaintiff on the facts before arriving at the opinion of Oroshnik's inventorship, etc. But the trial court has broad discretion in referring to specific evidence in the course of his charge. There was no prejudicial mistake in exercising such discretion here.

Criticism is voiced by plaintiff of the court's charge in relation to the willfulness, malice, or good faith attendant

upon defendants' acts. Basically, subject to the following comments, the charge was in our judgment correct. At one point, however, in relation to the liability of Oroshnik in acting upon the advice of Dr. Kell that he was the inventor, the court stated that "if they conspired together" (*i.e.*, Oroshnik and Kell) "he is certainly responsible for it. If it was reasonable, then he is not." Although we find this language neutralized by the charge as a whole, the reference to conspiracy as an antonym to non-actionable conduct in this context was inappropriate and could have been prejudicial.

Furthermore, the court's use of the term "malice" (or malicious) could have been misleading to the jury. In charging a jury in this area that term is best limited to the issue of punitive damages, since its ordinary meaning is spite or ill will, concepts not requisites to liability for general damages in relation to this tort. Legally, "malice" in this field of law means "the intentional doing of a wrongful act without justification or excuse." *Louis Kamin, Inc.* v. *Flink*, 113 N. J. L. 582, 588 (E. & A. 1934); and see *DiCristofaro* v. *Laurel Grove Memorial Park*, 43 N. J. Super, 244, 255-256 (App. Div. 1957). Therefore the jury should be told that it would be wrongful for defendants to specify Oroshnik as inventor on the patent if plaintiff was the inventor and if defendants knew or reasonably should have known that fact. Liability must here be premised upon knowledge, actual or reasonably imputable, since inventorship is a mixed question of law and fact, often reasonably debatable, and the requisite to liability, as indicated, is the "intentional doing" of the wrongful act. Good or bad faith were therefore properly charged here by the trial court as criteria of liability for general damages. But malice, as noted, if mentioned at all, should be expressly confined to the issue of punitive damages. (In

other respects the charge as to punitive damages below was essentially correct.)

Plaintiff complains that the trial court refused to instruct the jury that statements in an application by Ortho to the Canadian patent authorities for a patent on the process here involved averring patentability of the process constituted admissions evidential against Ortho. Although the request to charge was not precisely so framed, the general subject matter was covered therein. We think an instruction on the point would have been appropriate although we would not find reversible error in the omission, taken alone, since the pertinent evidence was admitted.

Patentability, as indicated above, is a mixed question of law and fact. Canadian law on patentability is essentially the same as United States law. See Patent Act, 1935, c. 32, §§2(d), 28; see also *Commissioner of Patents* v. *Ciba Ltd.*, [1959] S. C. R. 378; *Metalliflex Ltd.* v. *Rodi and Wienenberger*, [1961] S. C. R. 117. Ortho informed the Canadian authorities that notwithstanding the Beilstein reference the patent claim on the process was "clearly in an allowable condition." So far as that statement involved factual elements it was an admission by defendants contradictory to their trial position here. See *Bauman* v. *Royal Indem. Co.*, 36 N. J. 12 (1961); but see *Simmons Company* v. *A. Brandwein & Co.*, 250 F. 2d 440, 451-452 (7th Cir. 1957).

VIII.

Plaintiff's last major contention is the alleged unfair and prejudicial handling of the case as a whole by the trial judge against her and in favor of defendants. Detailed discussion of the items of complaint is unnecessary as there is to be a retrial in any event.

Appendix C—

Opinion of the Superior Court of New Jersey, Appellate Division.

We find no basis whatever for the implication that the trial judge was unfair and biased against plaintiff in his trial conduct. However, his demeanor during the trial may, perhaps, have unconsciously reflected his opinion, frankly expressed at the hearing of the plaintiff's motion for a new trial, that this action was "nothing but a continuation of a process of annoying the defendants because of the irritation of the plaintiff because of her discharge." Notwithstanding that private view, and our disagreement with some of his rulings, we think the trial judge endeavored conscientiously to discharge his duties in this difficult assignment with fairness and in accordance with the law. Much of the difficulty here lay in plaintiff's frequent refusal to accept trial rulings without extended argument, possibly due to her lack of experience in the conduct of a trial and her handicapped position as both attorney *pro se* and sole witness for her side of the case.

Miscellaneous additional points raised by plaintiff have been examined and found either without merit or inconsequential.

Reversed and remanded for a new trial as to defendants Ortho, Oroshnik, and Johnson & Johnson.

APPENDIX D

Constitution, Statutes, Rules of the United States Patent Office and Excerpts from the Manual of Patent Examining Procedure, U.S. Department of Commerce (1961).

United States Constitution

Art. I Sec. 8 Clause 8

Congress shall have Power to promote the Progress of Science and useful Arts by securing to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.

Art. VI

* * * This Constitution, and the Laws of the United States which shall be made in Pursuance thereof; and all Treaties made, or which shall be made, under the Authority of the United States, shall be the supreme Law of the Land; and the Judges in every state shall be bound thereby, any Thing in the Constitution or Laws of any State to the Contrary notwithstanding. * * *

28 U.S.C. 1257 (1)

Final judgments or decrees rendered by the highest court of a state in which a decision could be had, may be reviewed by the Supreme Court as follows:

(1) By appeal, where is drawn in question the validity of a treaty or statute of the United States and the decision is against its validity.

28 U.S.C. 2103

If an appeal to the Supreme Court is improvidently taken from the decision of the highest court of a state, or of a United States Court of Appeals, in a case where the proper mode of a review is by petition for certiorari, this alone shall not be ground for dismissal; but the papers whereon the appeal was taken shall be regarded and acted on as a petition for writ of certiorari and as if duly presented to the Supreme Court at the time the appeal was taken. * * *

§2403. Intervention by United States; constitutional question

In any action, suit or proceeding in a court of the United States to which the United States or any agency, officer or employee thereof is not a party, wherein the constitutionality of any Act of Congress affecting the public interest is drawn in question, the court shall certify such fact to the Attorney General, and shall permit the United States to intervene for presentation of evidence, if evidence is otherwise admissible in the case, and for argument on the question of constitutionality. The United States shall, subject to the applicable provisions of law, have all the rights of a party and be subject to all liabilities of a party as to court costs to the extent necessary for a proper presentation of the facts and law relating to the question of constitutionality.

35 U.S.C. 101. Inventions patentable

Whoever invents or discovers any new and useful

process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirement of this title.

35 U.S.C. 102. Loss of right to patent

A person shall be entitled to a patent unless * * *

(c) he has abandoned the invention * * *

35 U.S.C. 111. Application for patent

Application for patent shall be made by the inventor * * *

35 U.S.C. 112. Specification

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention. * * *

35 U.S.C. 115. Oath of applicant

The applicant shall make oath that he believes

himself to be the original and first inventor of the process, machine, manufacture, or composition of matter, or improvement thereof, for which he solicits a patent; and shall state of what country he is a citizen. * * *

35 U.S.C. 135. Interferences

Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be. The question of priority of invention shall be determined by a board of patent interferences (consisting of three examiners of interferences) whose decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent Office of the claims involved, and the Commissioner may issue a patent to the applicant who is adjudged the prior inventor. A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved from the patent, and notice thereof shall be endorsed on copies of the patent thereafter distributed by the Patent Office.

A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted.

35 U.S.C. 154. Contents and term of patent

Every patent shall contain a short title of the invention and a grant to the patentee, his heirs or assigns, for the term of seventeen years, of the right to exclude others from making, using, or selling the invention throughout the United States, referring to the specification for the particulars thereof. A copy of the specification and drawings shall be annexed to the patent and be a part thereof.

35 U.S.C. 251. Reissue of defective patents

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

35 U.S.C. 253. Disclaimer

Whenever, without any deceptive intention, a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid. A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing and recorded in the Patent Office; and it shall thereafter be considered as part of the

original patent to the extent of the interest possessed by the disclaimant and by those claiming under him.

Rules of the United States Patent Office

37 C.F.R. 1.41

Applicant for patent. (a) a patent must be applied for and the application papers must be signed and the necessary oath executed by the actual inventor in all cases, * * *

37 C.F.R. 1.205

Interference with a patent; copying claims from patent.

(a) Before an interference will be declared with a patent, the applicant must present in his application, copies of all the claims of the patent which also define his invention and such claims must be patentable in the application. . .

37 C.F.R. 1.216 (a) (4)

...the preliminary statement must set forth the following facts relating to conception of the invention: * * *

(4) The date of the first act or acts susceptible of proof...which, if proven, would establish conception of the invention, and a brief description of such act or acts; if there have been no such acts, it must be so stated. * * *

Manual of Patent Examining Procedure U.S. Department of Commerce (1961)

Sec. 706.03 (k) Duplicate Claims

Inasmuch as a patent is supposed to be limited to only one invention, or at most, several closely related indivisible inventions, limiting an application to a single claim, or a single claim to each of the related inventions might appear to be logical as well as convenient. However, court decisions have confirmed applicant's right to restate (i.e., by plural claiming) his invention in a reasonable number of ways. * * *

Sec. 806.05 (f)

A process and a product made by the process can be shown to be distinct inventions if . . . the product as claimed can be made by another and materially different process.

Sec. 1102.01 (b):

* * * when an interference is declared involving a patentee and the Examiner is of the opinion that the application or applications contain claims not patentably different from the issue of the interference, he should append to the letter to the applicant a statement that such claims, specifying them by number, will be held subject to the decision in the interference. The reason for making such statement applies equally well to an interference involving only applications. * * *

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